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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* YASUO TANO, MOTOHIRO KAMEI, MASAHITO OHJI,
YOSHIHIRO SAITOU, PARK IN WON, and JOHN M. LEWIS

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Appeal 2007-002543
Application 09/761,915
Patent 5,921,998
Technology Center 3700

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Decided:[1] June 22, 2009

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Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
FRED E. MCKELVEY, *Senior Administrative Patent Judge*, and
LINDA E. HORNER, *Administrative Patent Judge*.

HORNER, *Administrative Patent Judge*

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

Yasuo Tano et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of July 19, 2004 in reissue application 09/761,915. The reissue application seeks to reissue U.S. Patent 5,921,998, issued July 13, 1999, based on Application 09/058,183, filed April 10, 1998. The reissue application contains claims 1, 3, 4, 7, 9-15, and 21-33. The Examiner has rejected claims 1, 3, 4, 7, 9-15, and 21-27, and has indicated claims 28-33 are allowable. Claims 2, 5, 6, 8, and 16-20 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

## THE INVENTION

The Appellants' claimed invention is directed to an ophthalmic treatment tool for removing proliferative membranes in a treatment for proliferative vitreoretinal disorders (Spec. 1:3-7). Representative Figures 1a and 1b are reproduced below.

Fig.1a

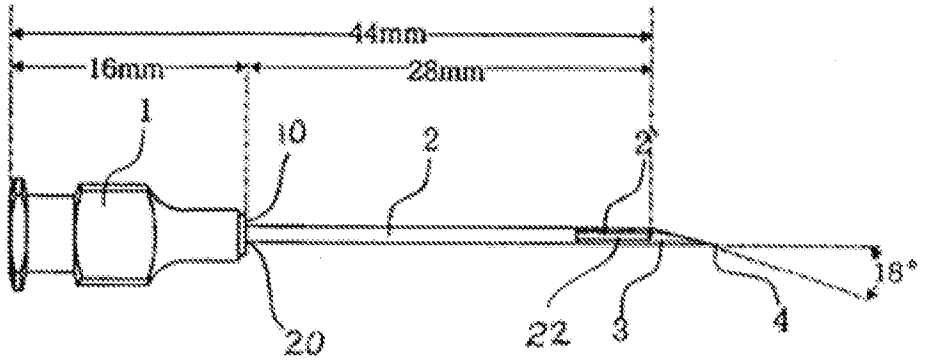


Fig.1b

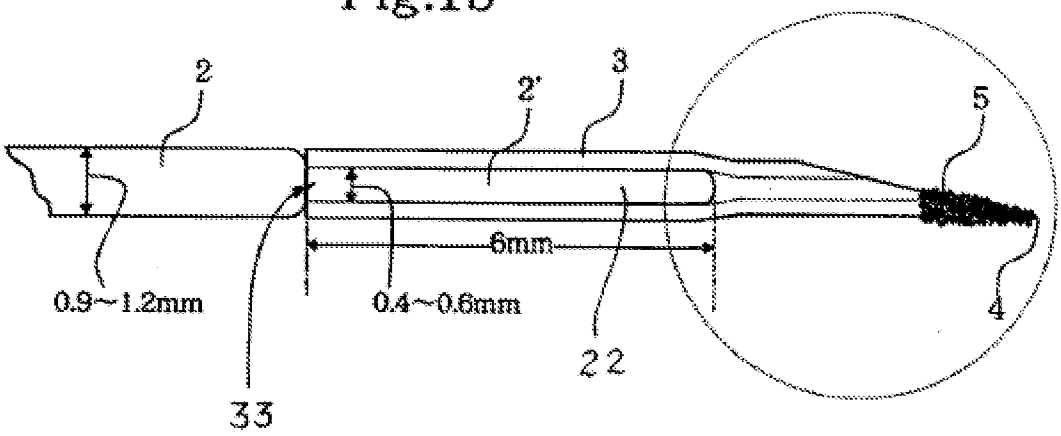



Figure 1a shows a side view of an ophthalmic treatment tool of one embodiment of the invention. Figure 1b shows a partially enlarged view of the ophthalmic treatment tool of Figure 1a (Spec. 3:31-34). As shown in Figures 1a and 1b, the ophthalmic treatment tool has a grip portion 1 and a rod-shaped body 2 having opposite first and second ends 20, 22. The first end 20 is attached to the grip portion 1. The second end 22 has a slender line portion 2′ having a reduced exterior diameter from that of the remainder of the rod-shaped body 2. The slender line portion 2′ is configured to receive an elastic body 3 fitted thereon. The elastic body 3 is provided with a tapered tip 4 having a group of hard, inorganic fine-grain particles 5 fixed thereon (Spec. 4:32 – 5:11).

Independent reissue claims 1, 9, 12, 21, and 26 on appeal read as shown in Appendix 4 attached. The remaining dependent reissue claims on

appeal read as shown in the claims appendix of Appellants' Appeal Brief, filed January 30, 2006, and are not reproduced herein.

## THE REJECTIONS

The Examiner relies upon the following evidence:

| | | |
|---|---|---|
| Varaine | US 5,118,291 | Jun. 2, 1992 |

The Appellants seek review of the following rejections:

1. The Examiner rejected reissue claim 26 under 35 U.S.C. § 102(b) as being anticipated by Varaine (Correction to Examiner's Answer, dated Sept. 5, 2007, pp. 1-2).
2. The Examiner rejected reissue claims 1, 3, 4, 7, 9-15, and 21-27 under 35 U.S.C. § 251 as "being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based" (Correction to Examiner's Answer, dated Sept. 5, 2007, pp. 2-3).

## ANTICIPATION ISSUE

The Appellants argue the Examiner erred in rejecting reissue claim 26 as being anticipated by Varaine, because Varaine discloses an instrument for cleaning teeth and does not disclose a "membrane eraser" and "does not have fine grains located on a tip for removing retinal membranes" (App. Br. 7-8). The Examiner found that the language of claim 26 fails to distinguish the claimed invention structurally from the Varaine device and

that the intended use of the claimed device is not entitled to patentable weight when no structural difference exists between the claimed invention and the prior art device (Ans. 3).

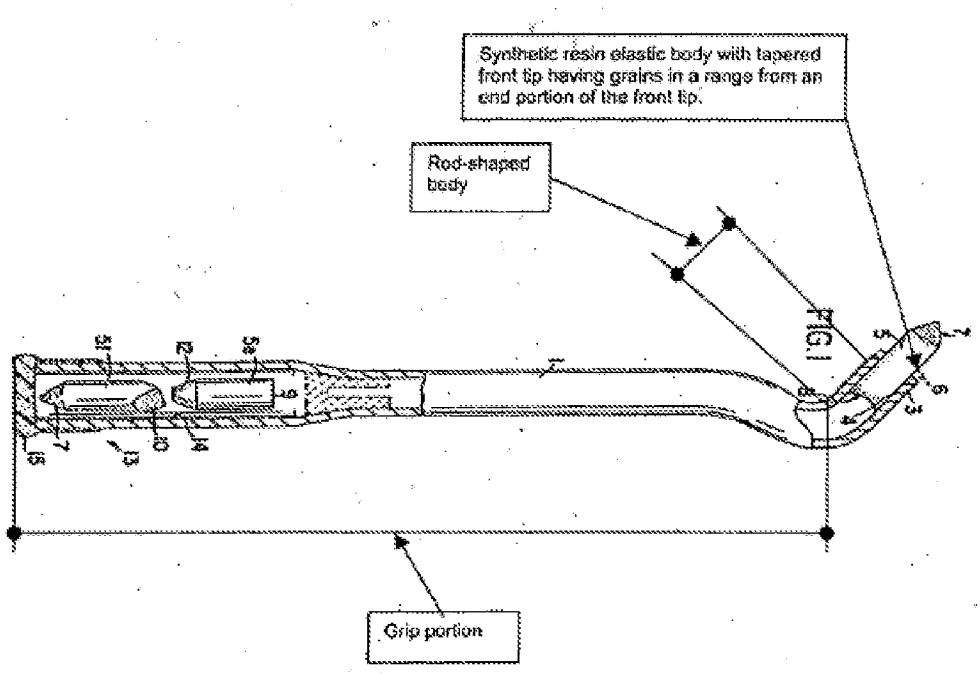
The first issue presented by this appeal is:

Have the Appellants established that the Examiner erred in finding that Varaine's device is structurally the same as the membrane eraser of claim 26?

## FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Examiner found that Varaine "discloses every structural limitation as recited in [claim 26]" by reference to Figure 1 of Varaine, as annotated by the Examiner (reproduced below):




(Correction to Examiner's Answer, dated Sept. 5, 2007, p. 2.)

2. The Appellants do not contest the Examiner's findings that Varaine's device discloses every structural limitation as recited in claim 26 (App. Br. 7-8).

3. The Appellants also do not argue or present evidence purporting to show that Varaine's device is incapable of use as a membrane eraser for removal of retinal membrane tissue (App. Br. 7-8).

## PRINCIPLES OF LAW

"It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citations omitted). A

patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). As stated in *Swinehart*, 439 F.2d at 213:

> where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

## ANALYSIS

The Examiner determined that the recitation of a "membrane eraser" in the preamble of claim 26 is merely a statement of intended use of the invention that does not structurally distinguish the claimed invention from Varaine's device (Ans. 3). The Examiner thus found that Varaine's device possesses the inherent characteristic of being suitable for use as a membrane eraser for removal of membrane tissue on a retina of an individual (*id.*).

The burden thus shifted to the Appellants to show why Varaine's device differs structurally such that it would not be capable of being used for removal of membrane tissue. The Appellants have not met this burden.

The Appellants do not contest the Examiner's findings that Varaine's device is structurally the same as the membrane eraser of claim 26 (Facts 1, 2). The Appellants also do not argue or present evidence purporting to show that Varaine's device is incapable of use as a membrane eraser for removal of retinal membrane tissue (Fact 3). Rather, the Appellants argue only that Varaine "does not identically show every element of the claimed invention" because "[t]he Varaine instrument is not a membrane eraser, and does not have fine grains located on a tip for removing retinal membranes" (App. Br. 8). In other words, the Appellants argue that the Examiner erred because Varaine does not "identically show" that its device is intended to be used as a membrane eraser used for ophthalmic surgery for removal of membrane tissue on a retina of an individual (App. Br. 8).

This argument fails to rebut the Examiner's finding that, although Varaine does not disclose using its instrument to remove retinal membranes, the Varaine instrument is structurally the same as the claimed membrane eraser and is thus suitable for such use. The Appellants, for example, fail to adequately establish any structural difference between the claimed hard inorganic fine-grains and Varaine's micrograins that would demonstrate that Varaine's device unsuitable for use as a membrane eraser used for ophthalmic surgery to remove retinal membrane tissue.[2] "It is well settled

[2] Further, the Appellants do not contend that the functional language recited in the fine grains limitation of claim 26 invokes 35 U.S.C. § 112, sixth

that the recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 128 F.3d at 1477 (citations omitted).

The Appellants have failed to show that the Examiner erred in determining that the prior art device is the same structure as the claimed membrane eraser such that the prior art device inherently possesses the characteristics that make it capable of use as a membrane eraser.

## RECAPTURE ISSUE

The Examiner found that the Appellants amended claim 1 of the application which matured into the patent sought to be reissued to include a "hollow tapered front tip" and grains "located in a range of 0.5 mm to 3.0 mm from an end portion of said front tip" and found that the Appellants argued (to overcome an anticipation rejection based on U.S. Patent 3,809,101 to Shimizu) that Shimizu does not disclose these features. The Examiner's recapture rejection is based on the fact that the present reissue claims 1, 3, 4, 7, 9-15, and 21-27 do not now include both of these features.

The Appellants argue that there was no mention of the specific 0.5 mm to 3.0 mm range in the prosecution argument distinguishing Shimizu and thus no evidence that the specific range was added during the original prosecution to distinguish over Shimizu (App. Br. 9). The Appellants

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paragraph, such that this limitation must be interpreted as means-plus-function claim language.

contend that the Amendment argues only that "Shimizu neither comprises a hollow tapered front tip nor teaches limiting the location of the grains to a range" (*id.*). Thus, the Appellants contend the recitation that the grains are located "in a range" from an end portion of the tip in each of the independent reissue claims is sufficient to avoid recapture (App. Br. 11).

The second issue presented by this appeal is:

Have the Appellants established that the Examiner erred in rejecting claims 1, 3, 4, 7, 9-15, and 21-27 under 35 U.S.C. § 251 based on recapture?

## ADDITIONAL FINDINGS OF FACT

*Prosecution history of the original application*

4. As filed, original application 09/058,183 contained claims 1-6 directed to a membrane eraser. A copy of originally-filed claims 1-6 is attached as Appendix 1.
5. On December 4, 1998, the Examiner entered a Non-Final Office Action ("Original Non-Final Action").
6. The Original Non-Final Action rejected claims 1-6 on various grounds.
7. The prior art relied upon by the Examiner in rejecting the claims was:

| | | |
|---|---|---|
| Shimizu | US 3,809,101 | May 7, 1974 |
| Morcher | US 4,285,072 | Aug. 25, 1981 |
| Calhoun | US 5,437,754 | Aug. 1, 1995 |
| Takahashi | US 5,735,793 | Apr. 7, 1998 |

8. The Examiner rejected (1) claims 1 and 4 under 35 U.S.C. § 102 as being anticipated by Shimizu, (2) claims 2 and 3 under 35 U.S.C. § 103 as being unpatentable over Shimizu in view of Calhoun, (3) claim 5 under 35 U.S.C. § 103 as being unpatentable over Shimizu and Morcher, and (4) claim 6 under 35 U.S.C. § 103 as being unpatentable over Shimizu in view of Takahashi.

9. On February 5, 1999, Appellants filed an Amendment in response to the Original Non-Final Action ("the Amendment").

10. The Amendment amended each of claims 1-6. A copy of the claims, as amended, is attached as Appendix 2.

11. After entry of the Amendment, the application claims were 1-6.

12. In the Amendment, Appellants presented arguments with respect to the patentability of amended claims 1-6.

13. Appellants' arguments (see below) in the Amendment addressed the following newly-added limitations of Appellants' amended claims 1-6:

(1) the fine grains "are located in a range of 0.5 mm to 3.0 mm from an end portion of said front tip for removal of membrane tissue on a retina of an individual," and

(2) the elastic body has "a hollowed tapered front tip."

14. In response to the rejection of claims 1 and 4 as being anticipated by Shimizu, the Appellants argued at pages 5-6 of the Amendment:

> [T]he membrane eraser is claimed [in claim 1] as including an elastic body having a hollowed tapered front tip in combination with a plurality of hard inorganic fine-grains fixed on a tapered front tip of the elastic member where the grains are located in a range of 0.5 mm to 3.0 mm from a tip-end portion of the front tip. This is clearly distinguished from the nail file filing an individual's nails as shown in Shimizu which neither comprises a hollow tapered front tip of an elastic body nor does the same teach limiting the location of the grains to the range presently claimed and instead teaches only the utilization of an abrasive sheet 9 which extends substantially the entire length of the holding member of two connecting portions 6, as best illustrated in each of Figures 2B and 3B thereof.

This argument addressed limitations (1) and (2) (see Finding of Fact 13) found in Appellants' amended claim 1.

15. In response to the rejections of claims 2, 3, 5, and 6, as being unpatentable over Shimizu in view of Calhoun (claims 2 & 3), Morcher (claim 5), and Takahashi (claim 6), the Appellants argued at page 6 of the Amendment:

> Calhoun, Takahashi et al and Morcher each do not teach an elastic body having a hollow tapered front tip or teach that a plurality of inorganic fine-grains are fixed on a tapered front tip of the elastic body wherein the grains are located in a range of 0.5

> mm to 3.0 mm from a tip end portion of the front tip. The failure of these references to teach or disclose these limitations can be readily understood from a review of Calhoun which is directed merely to an abrasive article having a lateral spacing between abrasive composite members while Takahashi et al only teaches an endoscope having a combination urging and covering member that not only covers the outer circumferential portion of a flexible tube but which also urges the flexible tube in a manner to be secured to a first tapered portion. Lastly, it is noted that Morcher only teaches an intraocular lens and method for implanting the same in a posterior chamber of an eye having a posterior capsule.

This argument again addressed limitations (1) and (2) (see Finding of Fact 13) found in Appellants' amended claim 1.

16. On February 16, 1999, the Office mailed a Notice of Allowability, which included an Examiner's amendment to claim 1, allowed claims 1-6, and stated that "[t]he Amendment by the applicant's Attorney has clearly distinguished the present invention to the prior art reference."

17. Application claims 1-6 correspond to patent claims 1-6, respectively.

18. U.S. Patent 5,921,998 issued July 13, 1999 based on the original application, and contained claims 1-6, copies of which are found in attached Appendix 3.

*Prosecution history of the reissue application*

19. Appellants filed reissue application 09/761,915 on January 17, 2001, seeking to reissue U.S. Patent 5,921,998.

20. Appellants presented amended original patent claims 1-6 along with new reissue application claims 7-20 for consideration.

21. Subsequently, on September 7, 2001, Appellants canceled claims 8 and 16-20 and added new reissue application claims 21-25 for consideration.

22. Subsequently, on March 10, 2003, Appellants canceled claims 2, 5 and 6 and added new reissue application claims 26-33 for consideration.

23. Ultimately, reissue application claims 1, 3, 4, 7, 9-15, and 21-27 are before the Board in this appeal. A copy of independent reissue claims 1, 9, 12, 21, and 26 on appeal is attached at Appendix 4.

*Independent Reissue Claims*

24. Independent reissue claim 1 recites a plurality of hard, inorganic fine-grains fixed on the tapered tip of the elastic body and located in a range from an end portion of the tip, but it omits the recitation that the fine grains are located in a range "of 0.5 mm to 3.0 mm" from an end portion of the tip.

25. Independent reissue claim 9 recites a plurality of hard, fine-grains fixed on the tapered tip of the elastic body and located in a range from an end portion of the tip, but it omits the recitation that the

fine grains are located in a range "of 0.5 mm to 3.0 mm" from an end portion of the tip.

26. Independent reissue claim 12 recites a plurality of hard, fine-grains fixed on the distal end of the elastic body and located in a range on the distal end portion, but it omits the recitation that the fine grains are located in a range "of 0.5 mm to 3.0 mm" from the distal end.

27. Independent reissue claim 21 recites an elastic, flexible tapered tip portion of the tool, but it omits the recitation that the tip is "hollow."

28. Independent reissue claim 21 also recites a plurality of hard, fine-grains fixed to the elastic portion of the tool and only located in a range from an end portion of the tapered tip, but it omits the recitation that the fine grains are located in a range "of 0.5 mm to 3.0 mm" from an end portion of the tapered tip.

29. Independent reissue claim 26 recites an elastic body having a tapered front tip, but it omits the recitation that the tip is "hollow."

30. Independent reissue claim 26 also recites a plurality of hard, inorganic fine-grains fixed on the tapered front tip of the elastic body and located in a range from an end portion of the front tip, but it omits the recitation that the fine grains are located in a range "of 0.5 mm to 3.0 mm" from an end portion of the front tip.

PRINCIPLES OF LAW

What has become known as the "recapture rule," prevents a patentee from regaining through a reissue patent subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement,* 131 F.3d 1464, 1468 (Fed. Cir. 1997).

If a patentee attempts to "recapture" what the patentee previously surrendered in order to obtain allowance of original patent claims, that "deliberate withdrawal or amendment … cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the [subject] matter withdrawn." *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995 (Fed. Cir. 1993) (quoting *Haliczer v. United States*, 356 F.2d 541, 545 (Ct. Cl. 1966)); *see also Hester Industries Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480 (Fed. Cir. 1998).

The Federal Circuit's opinion in *Clement* discusses a three-step test for analyzing recapture.

Step 1 involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims. The Federal Circuit reasoned that a reissue application claim deleting a limitation or element from a patent claim is broader as to that limitation's or element's aspect. 131 F.3d at 1468.

Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter. 131 F.3d at

1468-69. In this respect, review of arguments and/or amendments during the prosecution history of the application, which matured into the patent sought to be reissued, is appropriate. In reviewing the prosecution history, the Federal Circuit observed that "[d]eliberately canceling or amending a claim in an effort to overcome a [prior art] reference strongly suggests that the Applicant admits that the scope of the claim before cancellation or amendment is unpatentable." 131 F.3d at 1469. *See also Hester Industries*, 142 F.3d at 1481 ("an amendment to overcome a prior art rejection evidences an admission that the claim was not patentable").

The Federal Circuit determined in *Seattle Box Co. v. Industrial Crating & Packing, Inc.* that the recapture rule did not apply, because there was no evidence that Seattle Box's amendment of its originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable. 731 F.2d 818, 826 (Fed. Cir. 1984). According to the facts before the Federal Circuit, Seattle Box filed an application for a patent on February 17, 1977, in which claim 1 of the application stated that a double-concave spacer block had a "height substantially equal to the thickness of the tier of pipe lengths." 731 F.2d at 821. Seattle Box's patent attorney then narrowed claim 1 during the application's prosecution so as to specify that the spacer block had a height only "greater than the diameter of the pipe." *Id.* Soon after the attorney made this narrowing amendment, although not necessarily because of it, the patent examiner allowed each of the application's claims. *Id.*

Step 3 of the *Clement* test is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim. *Id.* The following principles were articulated in *Clement*, 131 F.3d at 1469-70:

> Sub-step (1): if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim;
>
> Sub-step (2): if the reissue claim is narrower in all aspects, the recapture rules does not apply, but other rejections are possible;
>
> Sub-step (3): if the reissue claim is broader in some aspects, but narrower in others, then:
>
> > (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;
> >
> > (b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

In *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335 (Fed. Cir. 2005), the Federal Circuit had occasion to further address sub-step (3)(a) of Clement. *North American Container* involved a reissue patent, which had been held invalid by the U.S. District Court for the

Northern District of Texas. The district court based its invalidity holding on a violation of the recapture rule. During prosecution of an application for patent, an examiner rejected the claims over a combination of two prior art references: Dechenne and Jakobsen. To overcome the rejection, North American Container limited its application claims by specifying that a shape of "inner walls" of a base of a container was "generally convex." North American Container convinced the examiner that the shape of the base, as amended, defined over "both the Dechenne patent, wherein the corresponding wall portions 3 are slightly concave … and the Jakobsen patent, wherein the entire reentrant portion is clearly concave in its entirety." 415 F.3d at 1340. After a patent issued containing the amended claims, North American Container filed a reissue application seeking reissue claims in which (1) the language "inner wall portions are generally convex" was eliminated, but (2) the language "wherein the diameter of said re-entrant portion is in the range of 5% to 30% of the overall diameter of said side wall" was added. Thus, the claim sought to be reissued was broader in some aspects and narrower in other aspects.

The Federal Circuit, applying the *Clement* three-step test, held that the reissue claims were broader in scope than the originally-issued claims in that they no longer require the "inner walls" to be "generally convex." The Federal Circuit further found that the broadened aspect (i.e., the broadened limitation) "relate[d] to subject matter that was surrendered during prosecution of the original-filed claims." 415 F.3d at 1350. The Federal

Circuit observed "the reissue claims were not narrowed with respect to the 'inner wall' limitation, thus avoiding the recapture rule." The Federal Circuit stated:

> [t]hat the reissue claims, looked at as a whole, may be of "intermediate scope" is irrelevant.... [T]he recapture rule is applied on a limitation-by-limitation basis, and ... [North American Container's] deletion of the "generally convex" limitation clearly broadened the "inner wall" limitation.

*Id.* Thus, the Federal Circuit in *North American Container* further refined sub-step (3)(a) of *Clement*: "broader in an aspect germane to a prior art rejection" means broader with respect to a specific limitation (1) added to overcome prior art in prosecution of the application which matured into the patent sought to be reissued and (2) eliminated in the reissue application claims.

## ANALYSIS

The Appellants present the same arguments for all of claims 1, 3, 4, 7, 9-15, and 21-27 and under a single heading in the Appeal Brief, and thus we treat the claims as having been argued as a group (App. Br. 8-11). We select claim 26 as the representative claim, and the remaining claims 1, 3, 4, 7, 9-15, 21-25, and 27 stand or fall with claim 26. 37 C.F.R. § 41.37(c)(1)(vii).

The Appellants do not dispute the Examiner's determination according to step 1 of the *Clement* test that the rejected reissue claims are

broader than the issued patent claims because they omit, among other things, the specific 0.5 mm to 3.0 mm range (Facts 24-30).[3,4]

The Appellants argue that the Examiner erred in rejecting reissue claims 1, 3, 4, 7, 9-15, and 21-27 under 35 U.S.C. § 251 because the Examiner erred in determining, according to step 2 of the *Clement* test, that this broader aspect of the reissue application claims, i.e., the omission of the specific 0.5 mm to 3.0 mm range, relates to surrendered subject matter (App. Br. 9). To determine the surrendered subject matter, we review the Appellants' arguments and amendments made during the prosecution history of the original application, which matured into the patent sought to be reissued.

During prosecution of the original application, the Appellants amended original claim 1 to overcome an anticipation rejection based on Shimizu (Facts 4-11) (Appendix 2). The Appellants' amendment added two limitations to claim 1: (1) the fine grains "are located in a range of 0.5 mm to 3.0 mm from an end portion of said front tip for removal of membrane tissue

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[3] Although reissue claims 1, 12, and 26 omit the recitation of a specific 0.5 mm to 3.0 mm range, newly-added reissue claims 7, 14, and 27, which depend from claims 1, 12, and 26, respectively, recite the 0.5 mm to 3.0 mm range. The Appellants, however, do not present any separate arguments for patentability of claims 7, 14, and 27 and thus have waived any arguments specific to the claim language presented therein. Claims 7, 14, and 27 stand or fall with representative claim 26. 37 C.F.R. § 41.37(c)(1)(vii).

[4] Representative claim 26 also omits the recitation that the elastic body has a "hollow" tapered tip (Fact 29).

on a retina of an individual," and (2) the elastic body has "a hollowed tapered front tip" (Fact 10) (Appendix 2). This deliberate amendment of application claim 1 in an effort to overcome Shimizu strongly suggests that the Appellants admit that the scope of the claim before amendment is unpatentable. *Clement*, 131 F.3d at 1469; *Hester Industries*, 142 F.3d at 1481.

This suggestion is confirmed by examination of the arguments presented by Appellants accompanying this Amendment. In particular, the Appellants argued that the membrane eraser of application claim 1 having a hollowed tapered front tip and fine grains located in a range of 0.5 mm to 3.0 mm from a tip-end portion of the front tip "is clearly distinguished from the nail file filing an individual's nails as shown in Shimizu which neither comprises a hollow tapered front tip of an elastic body nor does the same teach limiting the location of the grains *to the range presently claimed* and instead teaches only the utilization of an abrasive sheet 9 which extends substantially the entire length of the holding member of two connecting portions 6, as best illustrated in each of Figures 2B and 3B thereof" (Fact 14) (emphasis added). The Appellants further argued, in overcoming the obviousness rejections against claims 2, 3, 5, and 6, which depend from claim 1, that the prior art "do[es] not teach an elastic body having a hollow tapered front tip or teach that a plurality of inorganic fine-grains are fixed on a tapered front tip of the elastic body wherein the grains are located *in a range of 0.5 mm to 3.0 mm from a tip end portion of the front tip*" (Fact 15)

(emphasis added). In response to this claim amendment and arguments presented by the Appellants, the Examiner allowed claims 1-6 (Fact 16).

We disagree with the Appellants' contention that "[t]here is no mention of the specific 0.5 mm to 3.0 mm range in the prosecution argument distinguishing the Shimizu reference" (App. Br. 9). On the contrary, the Appellants' argument for amended claim 1 that refers to "the range presently claimed" is referring back to the specific range of 0.5 mm to 3.0 mm recited in amended claim 1 and described in the preceding sentence of the Amendment (Fact 14). Likewise, the Appellants' arguments for dependent claims 2, 3, 5, and 6 distinguish over the prior art by referring explicitly to the claimed "range of 0.5 mm to 3.0 mm from a tip end portion of the front tip" (Fact 15).

We also distinguish the facts presented in *Seattle Box Co. v. Industrial Crating & Packaging, Inc.*, 731 F.2d 818 (Fed. Cir. 1984), relied upon by the Appellants, from the facts now before us (App. Br. 10). In *Seattle Box*, the patentee's amendment to the claim during prosecution does not appear to have been in response to a prior art rejection and the record contained no evidence that the examiner allowed the claim based on the applicant's amendment. 731 F.2d at 821. In contrast, the Appellants' amendment to original application claim 1 in the present case is a direct response to the Examiner's anticipation rejection of claim 1 based on Shimizu, and the Appellant's accompanying arguments evince a clear reliance by the

Appellants' on this newly-added claim language to distinguish the claimed membrane eraser over the prior art.

The Appellants' Brief also alludes to step 3 of the *Clement* test in which reissued claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule (App. Br. 9). The Appellants have failed, however, to provide an adequate analysis of the rejected reissue claims to show how each claim is narrower in aspects that would avoid the recapture rule. For example, reissue claim 26 contains no narrowing language and is simply broader than amended application claim 1 in all aspects, and thus fails sub-step (1) of step 3 of the *Clement* test altogether (Compare Appendix 4 (claim 26) to Appendix 2 (claim 1)).

To the extent the Appellants are arguing that the recitation in each of the rejected independent reissue claims that the grains are located "in a range" is sufficient to overcome the recapture rule, we find this argument unavailing. While the recitation that the grains are "in a range" is narrower than the fine grains limitation of original claim 1, this recitation is broader than the surrendered subject matter, *viz*, fine grains in a range of 0.5 mm to 3.0 mm. Thus, the rejected reissue claims are broader in an aspect germane to the prior art rejection and fail sub-step (3) of step 3 of the *Clement* test. *North American Container*, 415 F.3d at 1350 (holding that "broader in an aspect germane to a prior art rejection" of the *Clement* test means broader

with respect to a specific limitation added to overcome prior art in prosecution of the original application and eliminated in the reissue claims).[5]

## CONCLUSIONS

The Appellants have failed to establish that the Examiner erred in finding that Varaine's device is structurally the same as the membrane eraser of claim 26.

The Appellants have failed to establish that the Examiner erred in rejecting claims 1, 3, 4, 7, 9-15, and 21-27 under 35 U.S.C. § 251 based on recapture.

## DECISION

The decision of the Examiner to reject claims 1, 3, 4, 7, 9-15, and 21-27 is AFFIRMED.

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[5] For the same reasons provided by the Board in *Ex parte Lanier*, No. 2007-3925, 2009 WL 789925, at *11 (BPAI March 23, 2009) (Judge MacDonald, concurring), we agree that the rationale of the majority in *Ex Parte Eggert*, 67 USPQ2d 1716 (BPAI 2003) (precedential) is inconsistent with the rationale of the Federal Circuit in *North American Container* and should no longer be followed or be applicable to proceedings before the USPTO. *See also* (1) *Lanier,* 2009 WL 789925, at *26-29 (Judge McKelvey, concurring) and (2) MPEP § 1412.02(I.C) (8th ed., Rev. 7, July 2008), demonstrating that the Director agrees.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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# APPENDIX 1

*Claims of Original Patent Application 09/058,183, as filed on April 10, 1998*

1. A membrane eraser used for an ophthalmic surgery, comprising:
a grip portion;
a rod-shaped body attached to one end of said grip portion;
an elastic body fitted along a direction toward a front end of said rod-shaped body to the front end side thereof; and
hard inorganic fine-grains fixed on a tapered front tip of said elastic body.

2. A membrane eraser according to claim 1, wherein said elastic body is made from silicone rubber.

3. A membrane eraser according to claim 1, wherein said hard inorganic fine-grains are grains having a range in diameter from 3 to 80 μ m.

4. A membrane eraser according to claim 1, wherein said hard inorganic fine-grains are diamond particles.

5. A membrane eraser according to claim 1, wherein said rod-shaped body is made from titanium.

6. A membrane eraser according to claim 1, wherein said hard inorganic fine-grains are fixed by a silicone base adhesive.

# APPENDIX 2

*Claims of Original Patent Application 09/058,183, as Amended on February 5, 1999*

(matter underlined added by the amendment)
(matter in [brackets] deleted by the amendment)

1. A membrane eraser used for an ophthalmic surgery, comprising:
a grip portion;
a rod-shaped body attached to one end of said grip portion;
an elastic body fitted along a directional toward a front end of said rod-shaped body to the front end side thereof and having a hollow tapered front tip; and
a plurality of hard, inorganic fine-grains fixed on [a] said tapered front tip of said elastic body wherein said grains are located in a range of 0.5 mm to 3.0 mm from an end portion of said front tip for removal of membrane tissue on a retina of an individual.

2. A membrane eraser according to claim 1, wherein said elastic body [is made from] comprise silicone rubber.

3. A membrane eraser according to claim 1, wherein said hard inorganic fine-grains [are] comprise grains having a range in diameter from 3 to 80 μm.

4. A membrane eraser according to claim 1, wherein said hard inorganic fine-grains [are] comprise diamond particles.

5. A membrane eraser according to claim 1, wherein said rod-shaped body [is made from] comprises titanium.

6. A membrane eraser according to claim 1, wherein said hard inorganic fine-grains are fixed by a silicone base adhesive to said front tip.

APPENDIX 3

*Claims of Patent 5,921,998, as Issued on July 13, 1999*

(matter underlined added by Examiner's amendment)
(matter in [brackets] deleted by Examiner's amendment)

1. A membrane eraser used for an ophthalmic surgery, comprising:
a grip portion;
a rod-shaped body attached to one end of said grip portion;
an elastic body fitted along a direction[al] toward a front end of said rod-shaped body to the front end side thereof and having a hollow tapered front tip; and
a plurality of hard, inorganic fine-grains fixed on said tapered front tip of said elastic body wherein said grains are located in a range of 0.5 mm to 3.0 mm from an end portion of said front tip for removal of membrane tissue on a retina of an individual.

2. A membrane eraser according to claim 1, wherein said elastic body [comprise] comprises silicone rubber.

3. A membrane eraser according to claim 1, wherein said hard inorganic fine-grains comprise grains having a range in diameter from 3 to 80 μ m.

4. A membrane eraser according to claim 1, wherein said hard inorganic fine-grains comprise diamond particles.

5. A membrane eraser according to claim 1, wherein said rod-shaped body comprises titanium.

6. A membrane eraser according to claim 1, wherein said hard inorganic fine-grains are fixed by a silicone base adhesive to said front tip.

# APPENDIX 4

*Independent Claims of Reissue Application 09/761,915, as Appealed*

1. A membrane eraser used for ophthalmic surgery, comprising:

a grip portion;

a rod shaped body having opposite first and second ends, said first end being attached to said grip portion, said second end extending away from said grip portion;

an elastic body having opposite proximal and distal ends and a hollow interior, said hollow interior at said proximal end receiving said second end of said rod-shaped body, said distal end having a tapered tip extending away from said rod shaped body; and

a plurality of hard, fine-grains fixed on said tapered tip of said elastic body, said fine-grains being located in a range from an end portion of said tip, said fine-grains being configured for removal of membrane tissue on a retina of an individual.

9. An ophthalmic treatment tool comprising:

a grip;

a rod shaped body having opposite first and second ends, said first end attached to said grip, said second end extending away from said grip;

an elastic body attached to said second end of said rod shaped body, said elastic body having a tapered tip extending away from said rod shaped body;

a plurality of hard, fine-grains fixed on said tapered tip of said elastic body, said fine-grains being located in a range from an end portion of said tip; and

said elastic body has a general cylindrical shape with opposite proximal and distal ends and a hollow interior, said proximal end is fitted onto said second end of said rod shaped body, said distal end is cut on a bevel forming said tapered tip.

12. An ophthalmic treatment tool comprising:

a grip;

a rod shaped body having opposite first and second ends, said first end attached to said grip, said second end having a slender line portion extending away from said grip;

an elastic body having a hollow, generally tubular shape with opposite proximal and distal ends, said proximal end having an opening receiving said slender line portion therein, said second end being spaced from said slender line portion and extending to a distal end having a taper; and

a plurality of hard, fine-grains fixed on said distal end of said elastic body, said fine-grains being located in a range on said distal end portion.

21. An ophthalmic membrane eraser comprising:

a tool having a length with opposite proximal and distal ends, a rigid portion of the tool adjacent the tool proximal end and an elastic, flexible tapered tip portion of the tool adjacent the tool distal end, the elastic portion of the tool is attached to the rigid portion of the tool and projects from the rigid portion of the tool for a portion of the length of the tool to the tool distal end, the elastic portion of the tool has a tapered tip at the tool distal end; and

a plurality of hard, fine-grains fixed to the elastic portion of the tool, the fine-grains are fixed to the elastic portion of the tool only located in a range from an end portion of the tapered tip and are absent from a remainder of the elastic portion of the tool so as not to detract from the flexibility of the remainder of the elastic portion of the tool.

26. A membrane eraser used for ophthalmic surgery, comprising:

a grip portion;

a rod shaped body attached to one end of said grip portion;

an elastic body fitted along a direction toward a front end of said rod shaped body to the front end side thereof and having a tapered front tip; and

a plurality of hard, inorganic fine-grains fixed on said tapered front tip of said elastic body wherein said grains are located in a range from an end portion of said front tip for removal of membrane tissue on a retina of an individual.